

REMARKS

The Applicant requests that the above Amendment be entered and the application be examined as amended and in view of the remarks below.

By this Amendment, the Applicant amended claims 1 and 2 to clarify the scope of the claimed inventions; amended claims 8, 13, and 14 to address §112 Rejections; and introduced new claims 15 and 16. The claim amendments were not made to overcome the cited art. Support for the invention recited in new claims 15 and 16 can be found in as-filed paragraph 0024 and in Figure 3 of the as-filed application.

I Response to §112 Rejection

On page 2 of the Action, the Patent Office Rejected claims 13 and 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The Applicant believes that the above amendment overcomes these rejections.

II Response to Obviousness Rejection Based upon Unwin and Beale

In the paragraphs bridging pages 2 and 3 of the Action, the Patent Office rejected claims 1-14 pursuant to 35 U.S.C 103(a) as obvious in view of the combined teachings of PCT publication WO 01/00501 of Unwin [herein “Unwin”] and U.S. Application publication 2003/0047838 of Beale, et al. [herein “Beale”]. The Applicant respectfully submits that these rejections are inappropriate and requests that these rejections be reconsidered and withdrawn based upon the following comments and observations.

It is well established in the law that for a 35 U.S.C. 103 obviousness rejection to be appropriate there must be some form of teaching, suggestion, or motivation in the cited art to combine their teachings. Specifically, Section 2143.10 of the MPEP provides the following guidelines concerning the appropriateness of combining the teachings of prior art references:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) [Emphasis added.]

Moreover, it is well established that there must be a reasonable expectation of success and the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

The Applicant submits that neither Unwin nor Beale provide any teaching, suggestion, or motivation to combine their teachings to produce the present invention. In addition, the Applicant submits that the nature of the problem to be solved "as a whole" by the present invention does not suggest that the teachings of Unwin and Beale be combined.

In response to the recent Supreme Court decision in *KSR v. Teleflex, Inc.*, the Applicant understands that some guidance when considering an obviousness rejection under 35 U.S.C. 103 was provided in a memorandum to Technology Center Directors from Margaret A. Focarino, Deputy Commissioner for Patent Operations, captioned "Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*," dated May 3, 2007. In this memorandum, Ms. Focarino first underscores the continued significance of the *Graham* inquiries, that is,

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Moreover, among other things, Ms. Focarino advises:

(4) The court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed.” The Court specifically stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis provided by Ms. Focarino)

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. (Emphasis provided by Ms. Focarino.)

The Applicant submits that Ms. Focarino’s advisories are particularly applicable to the present rejections under §103(a). In particular, the Applicant submits that there is no “apparent reason” to combine the teachings of the cited references. Furthermore, the Patent Office has not provided any “explicit” reasons for combining the teachings of the references, as promulgated by the Supreme Court’s instructions.

With regards to the present rejection of claims 1 and 2, which have been amended to more clearly recite the inventions for which the applicant is rightfully entitled (and which were not amended to overcome the cited art), the Applicant first brings to the Patent Office’s attention that the sole inventor that appears on Unwin is the very same inventor of the present application: Guy Darrel Unwin. Clearly, Mr. Unwin is intimately familiar with the invention disclosed in Unwin and its distinctions from the present invention. Note that Unwin is the very reference identified by the Applicant in the “Background of the Invention” and over which the present invention is an improvement.

Second, the Applicant respectfully submits that a *prima facie* case of obviousness, as set

out above, cannot be made when combining Unwin and Beale: these references or their combination do not suggest all the claim limitations of presently clarified claims 1 and 2.

It is unclear from the Patent Office's comments how Unwin and Beale are being combined to yield the inventions recited in claims 1 and 2. On page 3 of the Action, the Patent Office cites Unwin and its disclosure of a PTFE "outer layer" and "the inner layer is weave of glass." However, these teachings of Unwin do not address the aspects of the claimed invention. As recited in claims 1 and 2 (even before amendment), the present invention recites a "core layer of PTFE" and not an outer layer as disclosed by Unwin. Moreover, it is unclear why the Patent Office identifies Unwin's "inner layer... of glass"; the invention recited in claims 1 and 2 does not recite any inner glass layers.

The Applicant believes that it would be helpful to contrast the inventions illustrated in the cross section shown in Figure 3 of Unwin with the cross section shown in Figure 3 of the instant application. Clearly, the present invention includes a PTFE core layer 24 bounded by layers 25 and 26. Unwin simply comprises an outer PTFE layer 12 and an inner glass layer 11. Based upon these distinctions alone, these rejections are inappropriate and should be withdrawn.

Also, the Patent Office's reference to Unwin's statement "other materials suitable for this purpose are not excluded" is equally cryptic. Though other materials may be used for the "weave of glass," there is absolutely no teaching, motivation, or suggestion in Unwin (or in Beale) of what those other "weave of glass" type materials might be. Certainly, the materials PFA or FEP claimed in claims 1 and 2 are not mentioned by Unwin.

Uncharacteristic of a typical rejection under 35 U.S.C. 103(a), it is not until the last paragraph on page 4 that the Patent Office introduces a discussion of the teachings of Beale. However, the Applicant submits that Beale fails to provide the teachings missing from Unwin. Specifically, Beale does not remedy Unwin's failure to teach or suggest a "core layer of PTFE" or the "layers" of PFA and FEP. For this reason alone, these rejections are inappropriate and should be withdrawn, but still other distinctions between the claimed inventions and the cited art

underscore the inappropriateness of these rejections.

As clearly disclosed in at least paragraphs 0020 and 0024, Beale discloses “a blend” of materials to form molded cookware. Contrary to the present invention recited in claims 1 and 2, Beale does not disclose a layered structure. Specifically, in paragraph 0020, Beale discloses the use of “a blend of a fluoropolymer component and a silicone rubber component molded into a durable and flexible apparatus...” [Emphasis added.] This use of a blend by Beale is clearly consistent with Beale’s molding method of fabrication of the Beale cookware. Clearly, Beale does not disclose a layered structure as recited in claims 1 and 2.

In fact, as recognized by the Patent Office, Beale actually teaches away from a layered structure as recited in claims 1 and 2. As noted by the Patent Office, in paragraph 0006, Beale teaches away from the use of “fabric materials,” as in the present invention, due to their supposed “health hazards.” The MPEP at 2141.02 clearly advises that when considering the obviousness of a claimed invention in view of the prior art, is it impermissible to combine references that teach away from the claimed invention:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) [Emphasis added.]

The Applicant submits that Unwin and Beale not only do not disclose, teach, or even suggest the claimed invention as a whole, but Beale actually teaches away from the claimed invention.

Though the Applicant is aware that Beale mentions the materials PFA and FEP, there is absolutely no teaching or suggestion in Beale that these materials be provided as layers as claimed. In every instance, for example, in paragraph 0025 of Beale, these and related fluoropolymers are provided as a “blend” and not as a layered structure. Moreover, there is no teaching or suggestion in either Unwin or Beale that blended components of Beale can or should be somehow split into separate layers. The Applicant further submits that any attempt to read a layered structure into Beale having the claimed materials could only be undertaken with the

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benefit of hindsight, which, as the Patent Office is aware, is not permitted. Consequently, not only is the present invention not provided by combining the teachings of the cited references, but the teaching, motivation, or suggestion to make the claimed combination of layers and the reasonable expectation of success is not found in the cited art. Therefore, again, the Applicant respectfully submits that the inventions recited in claims 1 and 2 are not obvious in view of Unwin and Beale and the Applicant requests that these rejections be reconsidered and withdrawn.


With respect to the rejections of dependent claims 3-14, the Applicant submits that these claims are not obvious in view of Unwin and Beale for the same reasons that claims 1 and 2, from which they depend, are not obvious. The Applicant respectfully requests that these rejections also be reconsidered and withdrawn.

CONCLUSION

The Applicant believes that the above Amendment and Remarks place the application in allowable form. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully Submitted,



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